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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,397	12/19/2000	Satoshi Murata	107439-00027	2565

7590

09/15/2005

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EXAMINER

DALENCOURT, YVES

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,397

Applicant(s)

MURATA ET AL.

Examiner

Yves Dalencourt

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/11/05 & 8/12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is responsive to communication filed on 06/27/2005.

Response to Amendment

The examiner has acknowledged the amended specification and the supplemental information disclosure statement (IDS).

Response to Arguments

Applicant's arguments with respect to claims 1 - 8 have been considered but are moot in view of the new ground(s) of rejection.

Specification

The amendment filed on 06/27/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: " The map database 12 stores **geographic** positional data on a map " (page 2, last paragraph), and " thereby retrieving **geographic** positional data " (page 3, first paragraph).

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 – 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1 - 3, 5, and 7 – 8, the term “**geographic**” positional data is not disclosed. It has not been disclosed how such term is described in the specification. The examiner is unable to find or even interpret such term in the specification in order to find support for the claims. Therefore, one skilled in the art would know how to make and/or use the invention.

Claims 4 and 6 are necessarily rejected as being dependent upon the rejection of claims 1 and 5.

Therefore, the rejection is sustained since the amendment introduces new matter into the disclosure of the invention

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Andrew J. Kuzma (US 5,781,901; hereinafter Kuzma).

Regarding claim 1, Kuzma teaches a system for transmitting e-mail from a sender to a recipient using a configurable e-mail page (fig. 3; col. 1, lines 7 - 10), where each e-mail message is written on a web page provided by a communication center, and each communication terminal is provided in a mobile or fixed station (fig. 2; col. 3, lines 16 - 27), the system comprising a mail generating section for generating an e-mail message to be sent to an addressee “ as means for composing e-mail message to be sent to the recipient (col. 1, lines 25 - 33; col. 8, lines 12 – 28; col. 12, lines 28 - 43); an attachment reference which comprises a network address of the attachment, such as a “ URL” which indicates the position where the e-mail attachment is stored in the network (col. 1, lines 60 – 63; col. 5, lines 7 – 24 and lines 58 – 61; claimed a positional data storage section for storing a plurality of positional data, which is described similarly as the attachment reference of Kuzma in the specification on page 8,m lines 10 - 14); and a positional data attaching section for attaching one or more of the positional data stored in the positional data storage section to the e-mail message generated by the mail generating section (col. 5, lines 7 – 24 and lines 58 – 61; col. 6, lines 30 – 59; col. 7, lines 33 - 43).

Regarding claim 2, Kuzma teaches an e-mail sending and receiving system, wherein the positional data storage section includes a plurality of positional data registered by an addresser (col. 4, lines 33 – 40).

Regarding claim 3, Kuzma teaches an e-mail sending and receiving system, wherein the positional data storage section includes a plurality of positional data registered by the communication center (col. 3, lines 36 - 43).

Regarding claim 4, Kuzma teaches an e-mail sending and receiving system, wherein the mail generating section generates each e-mail message by using a format suitable for the communication terminal of the addressee, so that the communication terminal can read the e-mail message (paragraph bridging col. 12, line 59 through col. 13, line 3).

Regarding claim 5, Kuzma teaches an e-mail sending and receiving system, which further comprises a detailed data generating section for generating detailed data relating to each positional data attached to the e-mail message, and attaching a URL for accessing the detailed data to the e-mail message (fig. 7; col. 5, lines 55 – 62; col. 13, lines 33 - 52).

Regarding claim 6, Kuzma teaches an e-mail sending and receiving system, which further comprises a positional data register section for storing the detailed data in the positional data storage section according to a request from the communication terminal of the addressee (col. 5, lines 11 – 24; col. 8, lines 11 – 28; paragraph bridging col. 13, line 53 through col. 14, line 9).

Regarding claim 7, Kuzma teaches an e-mail sending and receiving system, wherein the positional data includes an address (col. 1, lines 59 – 63).

Regarding claim 8, Kuzma teaches an e-mail sending and receiving system, which comprises an attachment 420 stored in a file server of WWW HTTP server 320, an attachment reference 402 is generated which comprises a uniform resource locator (URL) pointer to the location of attachment 420 within WWW HTTP server 320 (col. 5, lines 54 – 61; claimed positional data on a map).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yves Dalencourt whose telephone number is (571) 272-3998. The examiner can normally be reached on M-TH 7:30AM - 6: 00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yves Dalencourt

August 29, 2005


ARIO ETIENNE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER